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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,249	10/31/2003	Masaaki Asonuma	SHO-0023	9039

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EXAMINER	
HSU, RYAN	
ART UNIT	PAPER NUMBER
3714	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/07/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/697,249	ASONUMA, MASAAKI	
	Examiner	Art Unit	
	Ryan Hsu	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 November 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

In response to the amendments filed on 11/22/06, claims 1 and 4 have been amended claim 6 has been newly added. Claims 1-6 are pending in the current application.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/697,004.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both the current application and co-pending application 10/697004 are directed towards "a gaming machine comprising a game result display means for displaying a game result thereon; and beneficial state generating means for generating a beneficial state for a player when a predetermined game result is displayed on the game result display means; wherein

the game result display means includes first display means and second display means arranged at a more front side than a display area of the first display means when seen from a front side of the gaming machine". Furthermore, claim 1 of the application 10/697004 is directed towards the "second display device has symbol display areas through which the symbols displayed on the first display means are transmittably displayed and window frame display areas are formed around the symbol display areas in the second display means". With regard to claim 1 of the current application 10/697249 the second display means requires a second display means having "second display means conducts a demonstration display in which a background thereof is displayed" and "light transmitting symbols are variably displayed in the background, after the game result is displayed on the first display means". These two requirements are directed towards the same invention where a "symbol display area" allowing light to transmittably display through the window frame display areas and the "light transmitting symbols" in a "demonstration display" both describe the same ability of allowing the second display symbol to allow light symbols to be represented on the second display. Therefore it would be obvious that these two inventions are not patentably distinct but simply have used a different language structure to detail the same invention. It would have been obvious to one of ordinary skill in the art to refer to a symbol display area with light transmitting symbols" as that of a "demonstration display" that incorporates the use of "light transmitting symbols" to signify the same invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Motegi et al. (US 6,817,946 B2) and in further view of Loose et al. (US 6,517,433).

Regarding claims 1 and 6, Motegi et al. teaches a gaming machine comprising a game result display means for displaying a game result thereon; and a beneficial state generating means for generating a beneficial state for a player when a predetermined game result is displayed on the game result display means (*see Fig. 5 and the related description thereof*) wherein the game result means includes first display means and second display means arranged in a display area and wherein the second display means conducts demonstration display in which a background thereof is display in dark color (*ie: see 'reel lamps' and also secondary display 5f of Fig 3 and the related description thereof*) so that the game result on the first display means is not seen and light transmitting symbols are variably displayed in the background after the game result is displayed on the first display means and wherein a part of the game result on the first display means is seen only through the light transmitting symbols while being variably displayed on the second display means (*ie: the beneficial state events of the secondary display illuminating the symbols of the first reel display*) (*see Fig. 5 and the related description thereof*). Furthermore, Motegi teaches a part of the game result on the first display means is seen only through the light transmitting symbols while being variably displayed on the second display

means (*see Fig. 5 and the related description thereof*). However, Motegi is silent with regard to an embodiment of the invention where the game result display means includes first display means and second display means arranged in front of a display area of the first display means when seen from a front side of the gaming machine. In an analogous gaming patent Loose et al. teaches an embodiment of the display device wherein the two displays may be placed one in front of the other so that the outermost display can alter its transmittance properties so that a viewer of the display area can view the reels behind the outermost display device. As taught by Loose either the use of a mirror as used in one embodiment of Loose and Motegi or the configuration of having one in front of the other would effectively allow for the different generated symbols and effects from each display device create an integrated image and allow for the two display devices to appear to the outside user as one integrated display (*see Fig. 1-2(a-b) and the respective related description thereof*). Therefore it would have been a simple matter of design choice to one of ordinary skill in the art at the time the invention was made to alter the configuration of Motegi as taught by Loose with a transmittal display in order allow for the dual display device to be configured in a way where a game result is displayed on a first display means and a second display means arranged in front of a display area of the first display means when seen from a front side of a gaming machine at the time the invention was made.

Regarding claim 2, Motegi teaches a gaming machine wherein the light transmitting symbols have specific shapes (*see 'reel symbols' of Fig. 3 and the related description thereof*).

Regarding claim 3, Motegi teaches a gaming machine that further comprises rear illumination means for illuminating the first display means from a rear side thereof (*see Fig. 3 and the related description thereof, col. 4: ln 28-39*).

Regarding claim 4, Motegi teaches a gaming machine that further comprises light transmitting mode memory means for storing a plurality of display modes of images including the background and the light transmitting symbols and light transmitting mode select means for selecting one or a plurality of display modes among the display modes stored in the light transmitting mode memory means wherein the second display means displays the images based on a selected result by the light transmitting mode select means (*ie: animated and effects display of the secondary display* (*see Fig. 5 and the related description thereof*).

Regarding claim 5, Motegi teaches a gaming machine wherein the first display means includes a plurality of symbol display parts capable of variably displaying one or a plurality of symbols and conducting stop display thereof and wherein the light transmitting symbols correspond to areas which are driven so that the player sees and recognizes a part of the symbol display parts (*see 'reels' 6(a-c) of Fig. 3 and the related description thereof*).

Response to Arguments

Applicant's arguments filed 11/22/2006 have been fully considered but they are not persuasive. With respect to applicant's arguments towards the improper use of a double-patenting rejection the Examiner respectfully disagrees. To begin with, the applicant has stated no arguments as to how the double patenting rejection fails to be proper but that it is deemed improper because it does not meet subparagraphs (a) and (b). To begin with the differences between the conflicting claims as stated by the rejection is that they use different phrases and words to describe the same invention. The two sets of claims are both directed towards the same game machine that signifies a beneficial result to the player however one makes a broad implementation of the function of the second display device by allowing it to display symbols

through a window frame display area and the use of an illumination device to vary the intensity of the illuminate the symbols ('004). The current application however is more specific with regards to the second display by qualifying it as a "demonstration display" (*ie: art equivalent of a display to display symbols*) wherein it uses a dark color to vary the amount of light that is allowed through so that symbols may have varying light intensities. As a result, these two are obvious to one of ordinary skill in the art for the reasons stated above at the time the invention was made. With regard to the applicant's arguments of claims 1-5, the applicant's arguments have been addressed above with the introduction of Motegi et al.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan Hsu whose telephone number is (571)272-7148. The examiner can normally be reached on 9 :00-17:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P. Olszewski can be reached on (571)272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RH

SCOTT JONES
PRIMARY EXAMINER

2/16/07